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PATENT  
2100/24

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl No.	:	10/090,685
Applicant(s)	:	Alfred THOMAS, Duncan F. BROWN, Lawrence E. DeMar, and Scott D. SLOMIANY
Filed	:	March 5, 2002
TC/A.U.	:	3711
Examiner	:	Vishu K. Mendiratta
Docket No.	:	2100/24
Title	:	SPIN KENO

Confirmation No. 8496

**REPLY BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Before the Board of Patent Appeals and Inferences:

This is in reply to the Examiner's Answer mailed September 5, 2006.

## **REMARKS AND ARGUMENTS IN REPLY**

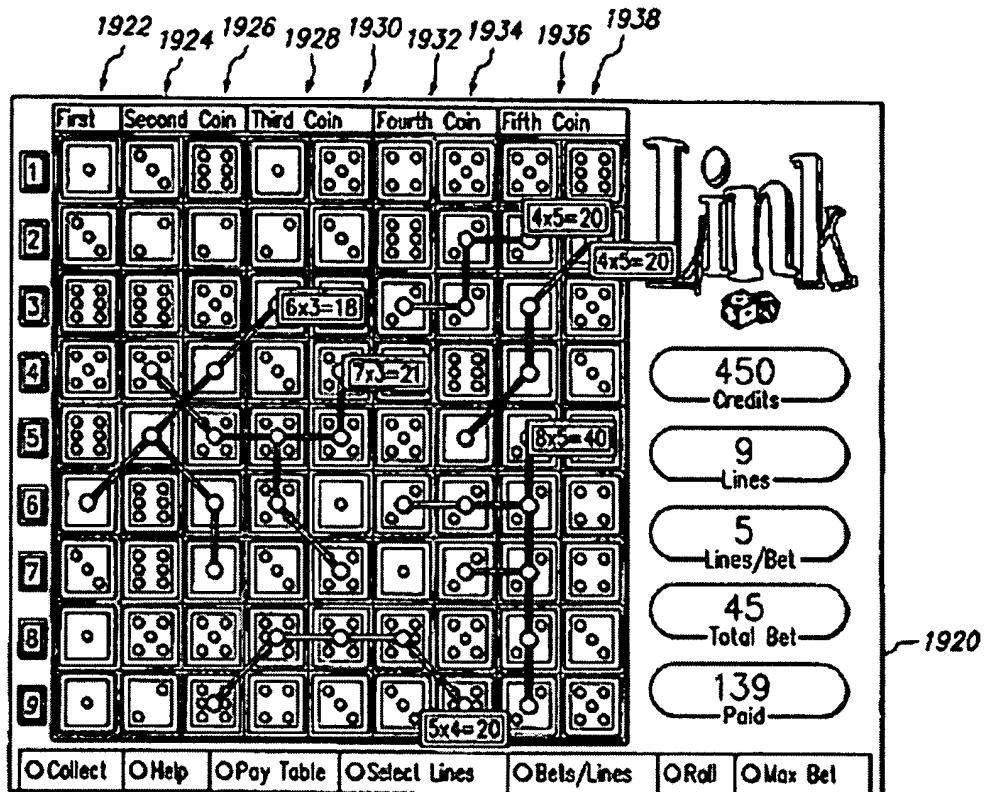
Claims 25-48 and 50-52 are on appeal. The Examiner's Answer maintains the rejection of Claims 25-48 and 50-52 under 35 U.S.C. §102(e) as being anticipated by Tarantino. The Examiner also maintained the rejection of Claims 25-48 and 50-52 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Simunek. The Examiner further maintained the rejection of Claims 37-38 and 44-46 under 35 U.S.C. § 103(a) as unpatentable over Simunek in view of Tarantino.

### **(I) WHY TARANTINO DOES NOT RENDER CLAIMS 25-48 AND 50-52 ANTICIPATED**

The Examiner argues Tarantino teaches a wagering input device (0 bet per line button) and player selecting game element locations less than all locations, but fails to acknowledge that there is no teaching of a “wagering input device” to register a wager independent from “registering a selection input” to select game element locations for gameplay. (Answer, p. 3).

Tarantino is a dice game and gaming system wherein a player attempts to obtain a predetermined combination of indicia, either in sequence or in linked or connected relationship. Tarantino teaches the position or arrangement of indicia, not how game element location selections are made independent of the wager that is feature of Applicants' invention. The Examiner's response that “none of applicant's claims carry the limitations ‘independent of’” (Answer, p. 5) is not germane in light of Applicants' claims read as a whole. Applicants' invention registers the selection of locations for gameplay and the wager separately, then the locations are played to reveal the game element indicia for the respective location. The Examiner cannot conflate these limitations in the manner done in the Answer; neither can the Examiner discuss Applicants' distribution with what is, in essence, a bootstrapped argument that the words “independent of” do not appear.

Furthermore, there can be no anticipation by Tarantino because Tarantino also does not disclose a player selecting multiple *locations*, or “less than all of said plurality of game element locations”. The Examiner's position that selecting each column is interpreted as selecting a location (Answer, p.5) is incorrect because the size of the bet dictates the columns played; there essentially is no “selecting a location”. If the player of Tarantino enters a first coin, a first column is played, as shown in Figure 6 of Tarantino below:



**FIG. 6**

If the player of Tarantino places a second coin, a second and third column is played. The player of Tarantino is not allowed to *select* columns four through nine for play upon placement of the second coin. Selecting columns in Tarantino based on the amount of the player's wager does not provide the player with the opportunity to select specific columns to play or individual game element locations within that column. What the Examiner is doing is trying to force the disclosure of Tarantino into something it is not.

The embodiment disclosed in Tarantino wherein the player must place individual bets prior to each selection of a single location further challenges the Examiner's argument that selecting each column is interpreted as selecting a location. In this embodiment of Tarantino, the amount of the player's wager is directly related to the selection of a location such that the bet/selection of Tarantino occurs in seriatim gameplay, which is in contrast to Applicants' invention where there is *no* seriatim placement of another wager for additional locations. Applicants' game is a variation of Keno in which the player places a wager *once and prior to* the selection of "less than all of said plurality of game element locations" to be played, unlike

Tarantino's selection of only one location subsequent to the placement of a bet. Here once more, the Examiner is not "playing fair" with the disclosure of Tarantino--which in no way discloses what the Examiner tries to contend it does.

Tarantino fails to disclose each and every element, *i.e.*, a "wagering input device" to register a wager independent from "registering a selection input" to select game element locations for gameplay and limiting a "selection to less than all of said plurality of game element locations" for gameplay of the independent claims 25, 29, 39, 47 and 50 and dependent claims thereon. Thus, Tarantino cannot anticipate these claims for these reasons.

## **(II.) WHY SIMUNEK DOES NOT RENDER CLAIMS 25-48 AND 50-52 ANTICIPATED, OR IN THE ALTERNATIVE OBVIOUS**

The Examiner argues that "reel action" is disclosed by Simunek through its capability "of selecting randomly 'some or all' locations: that then somehow indicates the possibility of selecting 'all' spots by the machine," which then turn into reel-like locations displaying symbols. (Answer, p. 4). Although independent claim 47 and dependent claims 26, 34, 43, 46, 48 and 52 include a reel presentation, the Examiner's "reel action" argument is simply not germane to the claims, because Simunek does not disclose "game element indicium to be displayed in each instance being randomly assigned for each said game element location", which is part of Applicants' invention.

In Applicants' invention, the player selects "spots" (*i.e.*, locations), which are then spun to determine whether any will ultimately have winning (*e.g.*, matching) indicia. Applicants do not employ randomly selected *spots or locations*, only randomly selected *indicia* at the player selected locations, to determine if there are any matches. One indicia from a set of indicium is randomly selected to be displayed *after* the player selects the game element spot or location to be played. The Examiner's response that Applicants' claims do not limit activation of locations to "only those locations selected by a player and no other location" (Answer, p. 6) is once again not relevant in light of Applicants' claims read as a whole. The Examiner is not giving a fair, and indeed ordinary, reading of the claim language. Instead, the Examiner seems to be misinterpreting the claim language in an effort to read an inapt prior art. It is not Applicants' arguments which "are outside [sic] claimed limitations"; Applicants' have properly positively claimed the limitation in terms of player picked locations. It is the Examiner's argument for a

further negative limitation that is outside, and not germane to the claims. Having a machine select “all” spots is not germane to Applicants’ invention.

Simunek fails to disclose, teach, motivate, or suggest “game element indicium to be displayed in each instance being randomly assigned for each said game element location” of the independent claims 25, 29, 39, 47 and 50 and dependent claims thereon, and these claims are not anticipated or obvious.

### **(III.) WHY SIMUNEK IN VIEW OF TARANTINO DOES NOT RENDER CLAIMS 37-38 OBVIOUS**

Allowance of independent Claim 29 would, of course, be enough, given that Claims 37-38 depend therefrom. Claim 37 further requires that the random assignment of game elements occurs for all said game element locations for a gameplay condition, and the winning condition further includes predetermined spatial arrangements of indicia in a matrix. Claim 38 further requires that the spatial arrangements include horizontal, vertical and diagonal lines.

Tarantino fails to disclose each and every element, *i.e.*, a “wagering input device” to register a wager independent from “registering a selection input” to select game element locations for gameplay or limiting a “selection to less than all of said plurality of game element locations” for gameplay of independent Claim 29 (and dependent claims thereon). Simunek fails to disclose or suggest “game element indicium to be displayed in each instance being randomly assigned for each said game element location” of independent claim 29, and further fails to fulfill the deficiencies of Tarantino.

The Examiner states Applicants’ arguments relating to the rejection of independent Claims 25, 29, 39, 47 and 50 are moot. (Answer, p. 6). It is believed the Examiner meant to state “[t]here is no record of independent Claims 25, 29, 39, 47 and 50 rejected over Simunek in view of Tarantino.” (Answer, p. 6). Applicants’ argued these independent claims are allowable over Simunek and Tarantino alone, or in combination, in response to the Examiner’s rejection of dependent Claims 37-38. Dependent claims include all the limitations of the claims from which they depend. As explained above, Tarantino and Simunek, alone or in combination, do not disclose or render obvious each and every element of independent Claim 29 and the further elements of Claims 37-38 dependent thereon. In the absence of these elements, Tarantino and Simunek cannot render Claims 37-38 obvious.

**(IV.) WHY SIMUNEK IN VIEW OF TARANTINO DOES NOT RENDER CLAIMS 44-46 OBVIOUS**

Dependent Claim 44 requires a plurality of paytables of increasing value from one payable to the next, and a respective payable being applied to determine an outcome of the game according to the aggregate number of game element locations selected. Dependent Claim 45 further requires the wager is based upon the aggregate number of game element locations selected and a wagered amount per location. Dependent Claim 46 requires that the wager is based upon the aggregate number of reels selected and a wagered amount per reel.

Again, Tarantino fails to disclose each and every element, *i.e.*, a “wagering input device” to register a wager independent from “registering a selection input” to select game element locations for gameplay or limiting a “selection to less than all of said plurality of game element locations” for gameplay of independent Claim 39 (and dependent claims thereon). Simunek fails to disclose or suggest “game element indicium to be displayed in each instance being randomly assigned for each said game element location” of independent Claim 39 and further fails to fulfill the deficiencies of Tarantino.

Tarantino in view of Simunek does not teach or suggest increasing the award according to aggregate number of game element locations selected. Although Tarantino discloses a higher award for larger selections, the additional selections are *only* offered upon additional bets. (13:1-5). Applicants’ invention does not offer additional bets to increase the award for larger selections. The player of Applicant’s invention places a wager once and prior to the selection of locations.

Applicants’ argued the independent claims are allowable over Simunek and Tarantino, alone, or in combination, in response to the Examiner’s rejection of dependent Claims 44-46. As explained above, Tarantino and Simunek, alone or in combination, do not disclose or render obvious each and every element of independent Claim 39 and the further elements of Claims 44-46 dependent thereon. In the absence of these elements, Tarantino and Simunek cannot render Claims 44-46 obvious.

**(V.) THERE IS NO MOTIVATION TO COMBINE THE TEACHINGS OF TARANTINO AND SIMUNEK, THUS FAILING TO RENDER CLAIMS 37-38 AND 44-46 OBVIOUS**

As noted above, independent Claims 29 and 39 are allowable over Simunek in view of Tarantino. There is no motivation or suggestion to combine Tarantino and Simunek to arrive at

the Applicants' invention claimed at Claim 29, and Claims 25-48 dependent thereon, and Claim 39 and Claims 50-52 dependent thereon. Not one of the prior art references teaches the play of the inventive Keno-type game that includes an abundance of locations (spots, reels, etc.), where a player enters a wager and then can select which locations will be used for a gameplay condition to ultimately determine an outcome. After the player selects the locations (or reels), the locations are played (*e.g.*, the reels are spun) to reveal the randomly selected game element indicia for the respective location.

The Examiner's hindsight and indeed extrapolative reasoning gleaned from the Appellants' disclosure is evident through the Examiner's unrealistic assertion that it would have been obvious to one skilled in the art to combine the dice game of Tarantino with the Keno-type game of Simunek. There is no teaching or suggestion to combine Tarantino, a game disclosing a matrix of die elements whereupon a player attempts to achieve a predetermined combination of die indicia, with Simunek, a game disclosing locations matched between player selected locations and randomly selected locations that turn into a slot "reel" display for spin.

Tarantino actually teaches away from Simunek. The player of Tarantino attempts to obtain a predetermined combination of indicia, either in sequence or in linked relationship. This teaches away from Simunek since a player is trying to match indicia of player selected locations to random machine selected locations. Simunek quite simply would not work if a player had to match a sequence of indicia with a randomly selected sequence. The punch board of Simunek would have far too many possibilities of sequenced indicia for a player to select in order to try and match to a machine selected sequence of indicia.

Besides, Tarantino requires additional bets to make additional selections in an attempt to receive a predetermined sequence of winning indicia. Tarantino's embodiment of additional bets for additional selections further teaches away from Simunek. If the player paid for multiple selections and matched a randomly selected spot in Simunek (Simunek discloses one wager), the game is not over. The spot turns into a reel, and in view of Tarantino, the player would have to make yet another bet to spin the reel in *attempt* to obtain a winning condition.

There is no suggestion or motivation to combine Tarantino with Simunek, and in fact, Tarantino and Simunek teach away from combining one another to satisfy the elements of independent Claims 29 and 39 and Claims 37-38 and 44-46 dependent respectively thereon.

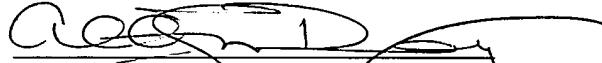
**(VI.) CONCLUSION**

It should be now apparent that the Examiner's reliance on Tarantino anticipating Claims 25-28 and 50-52, Simunek anticipating Claims 25-28 and 50-52 and Simunek in view of Tarantino rendering obvious Claims 37-38 and 44-46 is incorrect. The Examiner is morphing the claim language and the references. Neither Tarantino nor Simunek, alone or in combination, teach, suggest or provide the motivation to be combined in any arrangement to arrive at the Appellants' invention. Numerous elements in the Appellants' claims cannot be found in any reference. For at least the foregoing reasons, Appellants respectfully request that the Examiner's rejections be reversed and the Board allow Claims 25-48 and 50-52 under appeal.

Respectfully submitted,

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